

REMARKS

Reconsideration of the present application is respectfully requested.

In the Final Office Action, claims 1-6 and 39 were rejected under 35 U.S.C. § 102(e) based on U.S. Patent application publication no. 2002/0194584 of Suorsa et al. ("Suorsa"). Claims 7, 15, 17, 19, 27-29, 31, 40-41, 43-45, 47-49 and 51-53 were rejected under 35 U.S.C. § 103(a) based on Suorsa.

In the amendment after Final Office Action, filed on 6/5/2006, claims 1-14, 27-31 and 39 were canceled, no claims were amended or added. That amendment was entered, per the Advisory Action mailed on 7/11/2006. No claims have been amended, canceled or added in this response.

Therefore, claims 15-26, 32-28 and 40-55 are now pending.

Summary of Examiner Interview

A telephonic interview was conducted between the Examiner and Applicants' representative (the undersigned) on 7/20/2006. The Examiner's remarks in the Advisory Action were discussed. Agreement was not reached.

### Applicants' Remarks

Applicants respectfully traverse the rejections. Applicants reserve the right to swear *behind* Sousa in a future reply, if Applicants deem it necessary or appropriate to do so.

Applicants maintain all of the arguments presented in their response to the Final Office Action, filed on 6/5/2006. The Examiner's remarks in the Advisory Action do not withstand scrutiny, as explained below. The following remarks include a substantial repetition of Applicants' previously-presented arguments (which are maintained), followed by Applicants' specific response to the Advisory Action.

### Response to Final Office Action

Claim 15 recites that the secondary TPD is authorized to provision the mobile device *via a network*. Claims 40 and 44 recite similar limitations (note "remote source" in last element of claim 44). An agent 36 in Suorsa *cannot* be interpreted as the "secondary TPD" in these claims, because an agent 36 in Suorsa is implemented *within* the device to be provisioned; it does *not* communicate with the device to be provisioned *via a network*. Furthermore, there is no indication or suggestion in Suorsa as to why such a configuration/functionality would even be desirable. For at least this reason, therefore, claims 15, 40, and 44, and all claims which depend on them are patentable over Suorsa.

Regarding claims 20 and 32, claim 20 recites:

20. A method comprising:

operating a primary provisioning server within a predefined trusted environment, the primary provisioning server having authorization to provision a plurality of mobile devices on a wireless network;

**using the primary provisioning server to provision a digital certificate of the primary provisioning server in each of the mobile devices;**

**using the primary provisioning server to provision a digital certificate of a secondary provisioning server in the mobile devices, wherein the secondary provisioning server is on a second network outside the trusted environment; and**

using the primary provisioning server to provision the mobile devices with information indicating to the mobile devices authorization of the secondary provisioning server to provision the mobile devices.  
(Emphasis added.)

The Examiner admitted that Suorsa fails to disclose using the primary provisioning server to provision a digital certificate of the primary provisioning server in each of the mobile devices, or using the primary provisioning server to provision a digital certificate of a secondary provisioning server in the mobile devices, wherein the secondary provisioning server is on a second network outside the trusted environment (Final Office Action, p. 25). However, the Examiner cites Ramasubramani as providing the claim limitations not found in Suorsa.

On page 2 of the Final Office Action the Examiner responds to Applicants' previous arguments. The Examiner states:

Suorsa does not teach "provisioning digital certificates". Ramasubramani teaches using "digital certificates" (column 4 lines 29-30) in devices. Ramasubramani was used to teach the use of digital certificates and not the provisioning of devices. Suorsa teaches that "information stored in this database comprises all data that is necessary to provision a device" (paragraph 47) and that this information can include software components that are installed on each device, and logical information about the device (paragraph 47). This information can include any type of logical information including a digital certificate, which would be used to provide "the most secure use of authentication" (Ramasubramani: column 4, lines 29-31). Therefore, it is asserted that the CPA does teach the above limitation.

The Examiner seems to have missed Applicants' points. First, no combination of Suorsa and Ramasubramani teaches or suggests *all of the limitations* of claim 20 or claim 32. The fact is that neither Suorsa nor Ramasubramani, nor any combination thereof, discloses or suggests provisioning, in a mobile device, a digital certificate of a *provisioning server*, much less provisioning a digital certificate of a *secondary provisioning server* in the mobile device, nor do they suggest why it would be desirable to do so. Note that claim 32 includes similar limitations. Even if one accepts *arguendo* all of the Examiner's characterization of the cited references as true, this claim limitation is not taught or suggested by the resulting combination.

Furthermore, as previously stated, Ramasubramani clearly *teaches away* from the invention of claims 20 and 32, by teaching that digital certificates should be stored *in a centralized proxy server*, rather than in the device to be provisioned per claim 20 (col. 7, line 66 to col. 8, line 2). In view of this teaching away, Ramasubramani cannot be relied upon in any combination to render the present invention obvious.

The Examiner must also keep in mind that, under 35 U.S.C. § 103, the invention *as a whole* must be obvious in order to sustain an obviousness rejection. It is incorrect to argue that the separate elements or steps of a claim taken by themselves are known or obvious and that "therefore" the whole subject-matter claimed is obvious. Further, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266 (1992).

In light of the fact that the cited combination does not teach all of the claim limitations, and Ramasubramani's teaching away, no combination of Suorsa and

Ramasubramani renders the invention of claim 20 or claim 32 obvious as a whole. Therefore, claims 20 and 32 and all claims which depend on them are patentable over the cited art.

Further regarding independent claims 44 and 52, the cited art does not disclose or suggest the ability of a device to be provisioned (such as a mobile device) to *distinguish between* a message from a primary TPD as a remote source and a message from a secondary TPD as a remote source, as essentially recited in those claims. The Examiner failed to respond to this argument in the Final Office Action.

In Suorsa, the device to be provisioned relies upon its internal agent 36 to handle all provisioning tasks on the device. Since the agent 36 is within the device to be provisioned, it is *not a remote source* and therefore it cannot be interpreted as the primary TPD or the secondary TPD recited in claims 44 and 52. Furthermore, Applicants find no indication that the agent 36 or any other functionality in the device to be provisioned can *distinguish* provisioning messages from *two different remote sources*. Therefore, these claims and all claims which depend on them are patentable over the cited art for these additional reasons.

Further regarding independent claims 40 and 48, claim 40 provides:

40. (Previously presented) A method of operating a mobile device on a wireless network, the method comprising:  
receiving a provisioning message from a first trusted provisioning domain (TPD), **the provisioning message specifying a second TPD and indicating a parameter which the second TPD is authorized to provision in the mobile device**, the secondary TPD comprising a provisioning server;

**storing information identifying the second TPD and the parameter in response to the provisioning message; and provisioning the parameter in the mobile device in response to a provisioning message received over a network from the second TPD.**  
(Emphasis added.)

Claim 48 contains similar limitations.

The cited art does not disclose or suggest any functionality, in a device to be provisioned (such as a mobile device), by which the device is initially provisioned by a first trusted provisioning domain (TPD), to enable it to be subsequently provisioned by a second TPD. More specifically regarding claims 40 and 48, the cited art fails to disclose or suggest *storing information identifying the second TPD and the parameter in response to the provisioning message*.

On page 3 of the Final Office Action the Examiner responds to Applicants' previous arguments. The Examiner states:

The CPA discloses "the agent communicates with the provisioning network 31 to obtain commands regarding tasks that need to be performed on its device" (paragraph 47). The commands can be viewed as the provisioning message as they contain instructions on how to provision the device. Therefore, it is asserted that the CPA does teach the above limitation.

Even if the Examiner's interpretation is accepted *arguendo* as true, Suorsa still does not disclose or suggest *storing information identifying the second TPD in response to the provisioning message*, nor does Suorsa even suggest why it would be desirable to do so. The Examiner previously interpreted the agent 36 in Suorsa to be the "second TPD" in Applicants' claims. However, since the agent 36 is within the device to be provisioned, there is no reason that it would store information identifying itself in response to a provisioning message. Likewise, Ramasubramani also fails to disclose or

suggest such functionality. Therefore, claims 40 and 48 are further patentable over the cited art, along with their dependent claims, for these additional reasons.

### Applicants' Response to Advisory Action

In the Advisory Action (continuation sheet), the Examiner responds to Applicants' arguments (reiterated above) as follows:

[1] The Applicant argues that the Cited Prior Art (CPA), Soursa . . . does not teach provisioning the mobile device via a network. This argument is not found persuasive. In the embodiment wherein a gateway is used, the gateway can be viewed as a secondary TPD and the file/database servers being the primary TPD as they provide the provisioning information to the agents if there is not gateway [sic] (paragraphs 50-52). The gateway instructs the agents of the provisioning instructions via a network (Figure 7, paragraphs 50-52). [2] Furthermore, the Applicant argues that the CPA does not teach provisioning of a digital certificate of a secondary TPD in a mobile device. Soursa teaches that the device can be provisioned either through a component of the provisioning network (database/fileserver) or through a gateway (paragraphs 50-51). [3] These can be viewed as a two separate TPDs. Furthermore, Soursa states that the communication with the agent needs to be secure (paragraph 50), and that every communication between the remote agent and either the gateway or the file/database server can be authenticated by means of a digital certificate (paragraph 50). [4] Ramasubramani also teaches placing digital certificates on devices (col. 4, lines 29-30). Soursa states that "information stored in the compounds that are installed on each device, and logical information about the device (paragraph 47). This information can be interpreted as a digital certificate Soursa teaches the use of digital certificates for authentication between the provisioning devices and the remote agent.

To facilitate discussion, Applicants have labeled the Examiner's statements above with reference numerals (e.g., [1], [2], etc.).

Regarding independent claims 15, 40, 44 and 48, the Examiner contends that the gateway 38 in Soursa can be considered a secondary TPD per applicants claims (statements [1] and [3] above). That is incorrect. The gateway 38 in Soursa is merely

an *intermediary network node*, which simply *forwards* provisioning messages generated by *other devices*. The gateway 38 does not perform any provisioning itself and therefore cannot be considered a TPD or provisioning server.

More specifically with regard to the claims, claim 15, for example, requires sending to a mobile device a provisioning message *specifying a secondary TPD authorized to provision the mobile device via a network and an identifier of one or more parameters which the secondary TPD is authorized to provision*, the secondary TPD comprising a provisioning server. Nowhere does Soursa disclose or suggest that any of the devices 1, 2, . . . N or agents 36 receive a message that specifies *the gateway 38 as a TPD* (or provisioning server) or any parameters that *the gateway 38 is authorized to provision*. Claims 40, 44 and 48 include similar limitations; thus, these comments also apply to those claims.

Therefore, the Examiner's statements [1] and [3] above lack merit, and Applicants' arguments presented above regarding claims 15, 40, 44 and 48 should be deemed persuasive.

Regarding claims 20 and 32, the Examiner responds to Applicants' arguments in statements [2] through [4] above. The Examiner contends that Ramasubramani teaches placing digital certificates on devices at col. 4, lines 29-30 (statement [4]). However, the technique taught in Ramasubramani stores digital certificates *on a centralized proxy server*, not in mobile devices (see abstract, lines 8-9; col. 7 line 65 – col. 8, line 2). Ramasubramani does mention prior art which traditionally stored digital certificates in mobile devices, but that prior art and the technique which

Ramasubramani teaches relate to digital certificates of *the mobile devices*, not digital certificates of a *provisioning server*.

Consequently, even if all of the Examiner's statements are accepted as true (for the sake of argument), the combined teachings of Soursa and Ramasubramani still could not produce or teach provisioning a digital certificate of a *secondary provisioning server* in a mobile device. Neither Soursa nor Ramasubramani discloses or suggests the use of a *secondary provisioning server* authorized to provision a mobile device, much less that a primary provisioning server provisions the digital certificate of a secondary provisioning server in a mobile device.

Therefore, Applicants' arguments presented above regarding claims 20 and 32 should be deemed persuasive.

In addition, the Examiner has thus far made no attempt to respond to Applicants' arguments regarding independent claims 44 and 52 (reiterated above). During the telephone interview on 7/20/2006, the Examiner indicated his belief that those arguments had been overlooked. Applicants therefore request that those arguments now be considered.

### Dependent Claims

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, Applicants' silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding that claim.

Conclusion

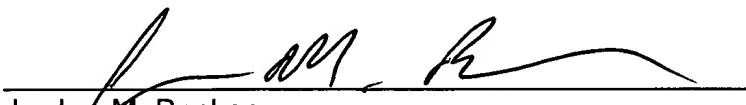
For the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly requested.

If any additional fee is required, please charge Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated:

8/30/06   
Jordan M. Becker  
Reg. No. 39,602

Customer No. 26529  
12400 Wilshire Blvd.  
Seventh Floor  
Los Angeles, CA 90025-1026  
(408) 720-8300